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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CUMBERLEDGE, JERRY L

ART UNIT PAPER NUMBER

3733

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/698,638	<b>Applicant(s)</b> SHORES ET AL.	
	<b>Examiner</b> Jerry Cumberledge	<b>Art Unit</b> 3733	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
It does not identify the citizenship of each inventor.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Dependent claim 6 is written as dependent on itself. Claim 6 will be considered dependent on claim 1 for examination purposes.

Claim 9 contains the phrase "...said at least one locking member urging in said locked position urging said dissection tool..." The grammar of this phrase must be corrected.

Claim 12 contains the phrase "...further comprising a shaft..." The second shaft should be given a distinct identifier (e.g. a second shaft) from the first claimed shaft.

Claim 12 contains the phrase "...further comprising a shaft..." The second shaft should be given a distinct identifier (e.g. a second shaft) from the first claimed shaft.

In claim 14, line 1 the word --a—should be inserted between "coupling" and "power".

In claim 19, the word –three—should replace the word "there".

Claim 21 contains the phrase "...further comprising a shaft..." This shaft should be given a distinct identifier from the first claimed shaft (e.g. a second shaft).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Mickel et al. (US Pat. 6,062,575).

Mickel et al. disclose a coupling system, for a medical dissection tool, the coupling system configured to interconnect with a power source to a dissection tool, the coupling system comprising: a coupling shaft (Fig. 1A, ref. 60) having a proximal portion for receiving power from the power source (column 5, lines 52-58), a distal portion and a longitudinal axis, said distal portion having an external surface and defining an internal passage (Fig. 1A, surrounding ref. 54) adapted for receiving a portion of the medical dissection tool (Fig. 1A, ref. 50), and at least one aperture (Fig. 1A, ref. 80) extending from said external surface to said internal passage; and at least one locking member (Fig. 1A, ref. 82) positioned adjacent said at least one aperture and movable through a first path in a direction at least partially parallel to said longitudinal axis into a locked position to prevent the medical dissection tool from moving along the longitudinal axis of the internal passage (column 7, lines 17-25).

The first path is created by moving the at least one locking member toward the tool shaft and in a direction parallel to the longitudinal axis. The ball will roll longitudinally with respect to the tool and move into the aperture (Fig. 1A and Fig 1B). The first path extends at an angle of approximately 45° to the longitudinal axis. The first path will extend at an angle of about 45 degrees, since the engagement sleeve (Fig. 1B, ref. 71) has an internal contact surface (Fig 1B, ref. 72) which is angled at about 45 degrees (Fig. 1B, ref. 72). The at least one locking member comprises a spherical ball (Fig. 1A, ref. 82). The at least one locking member comprises three locking members (column 6, lines 19-26). The at least one locking member comprises three spherical balls (column 6, lines 19-26). The proximal portion and said distal portion are integrally formed on a single shaft (Fig. 1A) (column 5, lines 58-63). The coupling system further comprises an engagement sleeve (Fig. 1B, ref. 71) disposed adjacent said distal portion, said engagement sleeve having an internal contact surface (Fig 1B, ref. 72) configured for engaging the at least one locking member into a locked position through the first path. The dissection tool includes a proximal end (Fig. 1A, ref, 50) and said internal passage includes an internal shoulder (Fig. 1A, ref. 64), said at least one locking member in said locked position urging said dissection tool proximal end against said internal shoulder.

The system further includes a biasing member (Fig. 1A, ref. 40) urging said engagement sleeve to contact said at least one locking member to move to said locked position. The at least one locking member moves through a second path into an unlocked position. The system further comprises a shaft (Fig. 1a, ref. 52) wherein at

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least one opening (the openings near ref. 52, Fig. 1B) in the shaft holds the at least one locking member (Fig. 1B). The coupling system of claim 1 further comprises a retention member (Fig. 1B, ref. 54) residing inside the internal passage wherein the retention member is configured to couple with one end of the medical dissection tool (Fig 1B).

Mickel et al. further disclose a coupler for coupling a power source to a surgical dissection tool having a longitudinal axis, the coupler comprising: a housing (Fig. 1A, ref. 65) defining an outer surface with a portion adapted for coupling to the power source (column 5, lines 52-58) and an internal passage (Fig. 1A, surrounding ref. 54) for receiving a portion of the dissection tool, an aperture (Fig. 1A, ref. 80) defined between said outer surface and said internal passage; and at least one locking member (Fig. 1a, ref 82) disposed adjacent said aperture, said locking member moveable at least partially along the longitudinal axis from an, unlocked position disposed substantially outside said internal passage (Fig. 1A) to a locked position having at least a portion of said locking member disposed within said internal passage (Fig.1B); and an engagement member (Fig. 1B, ref. 71) disposed adjacent said aperture for urging the locking member into the locked position through a first path. The first path includes movement of the locking member toward the dissection tool and movement parallel to the longitudinal axis. The ball will roll longitudinally with respect to the tool and move down towards the tool (Fig. 1A and 1B). The first path is at approximately 45° to the longitudinal axis. The first path will extend at an angle of about 45 degrees, since the engagement sleeve (Fig. 1B, ref. 71) has an internal contact surface (Fig 1B, ref. 72) which is angled at about 45 degrees (Fig. 1B, ref. 72). The locking member comprises a

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spherical ball (Fig. 1A, ref. 82). The coupling assembly comprises two additional locking members (column 6, lines 19-26). The three locking members comprise three spherical balls (column 6, lines 19-26). The locking member moves through another path into an unlocked position. The path would be reversed in the unlocking step. The coupler further comprises a shaft (Fig. 1a, ref. 52) wherein an opening (the opening near ref. 52, Fig. 1B) in the shaft holds the locking member.

A coupling assembly joining a power source to a medical dissection tool having a longitudinal axis, the coupling assembly comprising: a coupling housing (Fig. 1A, ref. 65) having a proximal portion configured to receive power from the power source (column 5, lines 52-58) and a distal portion configured to receive a portion of the dissection tool (Fig. 1A, surrounding ref. 54); and a means for locking the dissection tool to the coupling housing configured to move the dissection tool within the coupling housing along the longitudinal axis. The means include the balls (Fig. 1A, ref. 82), the engagement sleeve (Fig. 1B, ref. 71), the biasing member (Fig. 1A, ref. 40), and the shaft (Fig. 1a, ref. 52) with openings (the openings near ref. 52, Fig. 1B). The coupling housing includes an internal bore (Fig. 1A, surrounding ref. 54) configured to receive the dissection tool, and the internal bore includes an internal shoulder (Fig. 1A, ref. 64), said means for locking configured to move the dissection tool into an abutting engagement with said internal shoulder in a locked position (Fig. 1A and Fig. 1B).

With regard to the statements of intended use and other functional statements (e.g. ...configured for engaging...), they do not impose any structural limitations on the claims distinguishable over the coupling system of Mickel et al., which is capable of

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being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see attached PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry Cumberledge whose telephone number is (571) 272-2289. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLC



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER